



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/805,864

03/22/2004

Gary M. Johnson

A-3061-AL

1803

21378

7590

08/08/2008

APPLIED MEDICAL RESOURCES CORPORATION

22872 Avenida Empresa

Rancho Santa Margarita, CA 92688

EXAMINER

HALL, DEANNA K

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

08/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/805,864	<b>Applicant(s)</b> JOHNSON ET AL.	
	<b>Examiner</b> DEANNA K. HALL	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-13,16,25,26 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-13,16,25,26 and 40-43 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application      |
| Paper No(s)/Mail Date <u>April 8, 2008</u>   | 6) <input checked="" type="checkbox"/> Other: <u>IL-158889 (Popov)</u> |

## **DETAILED ACTION**

### ***Acknowledgments***

1. This office action is in response to the election of species filed April 8, 2008.
2. In the reply, the applicant canceled claims 29-35; claims 5, 7, 14-15, 17-22 and 36-39 have been withdrawn.
3. Applicant has elected the species of Figures 4-12 and has indicated claims 1-4, 6, 8-13, 16, 23-28 and 40-44 to be readable on the elected species.
4. On July 21, 2008 by a telephone call with Attorney David Majdali, claims 23, 24, 27 and 28 which were originally believed readable on the species of Figs. 4-12 were withdrawn as actually being readable on Figs. 13, 14 and 16 (non-elected species).
5. Thus, claims 1-4, 6, 8-13, 16, 25-26 and 40-44 will be examined in this action.

### ***Information Disclosure Statement***

6. The information disclosure statement (IDS) submitted on April 8, 2008 is in compliance with the provisions of 37 CFR 1.97(b). Accordingly, the IDS is being considered by the Examiner.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**8. Claims 1-2, 4, 6, 8-13, 25-26, 40-43 are rejected under 35 U.S.C. 102(a) as being anticipated by IL-158889 ("Popov").** Popov discloses a surgical access port comprising:

An elongate tubular body 51 having a lumen 77 and a tip 49, 50 connected to and disposed at the distal end of the tubular body capable of penetrating through a body wall; the tip in a first, penetrating position blocks the lumen of the elongate body and the tip is capable of swinging from the first penetrating position to a second, retaining position to unblock the lumen of the elongate body, see Figs. 12-17, 19.

The port of Popov further comprises a seal housing 44 to allow passage of surgical instruments 77. The tip is substantially blunt or has a conical surface, Fig. 12.

The tip of Popov is capable of repositioning to one side of the tubular body when no axial load is present and is capable of remaining in an off-axis condition until removal of the access port whereby it is then capable of realigning with the axis of the tubular body. The repositioned tip of Popov is capable of remaining in a substantially right-angled condition.

The tubular body is a thin walled tube capable of allowing passage of surgical instruments through the body wall and into the body cavity, see Fig. 19.

The tip of Popov is capable of being a non-expanding tip or a non-compressible tip.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popov in view of Roth (US 5,626,598).**

Popov discloses the invention as substantially claimed (see above). However, Popov does not directly disclose the tip of the tubular body being sharp, pointed or bladed. Roth, in the analogous art, teaches a trocar assembly with a tip capable of having several configurations including sharp, pointed or bladed, see Figs. 8, 10, 12, 14, 16, 18, 20. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Popov with the tip of Roth for more easily puncturing the body wall.

**11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popov.**

Popov discloses a tubular body 51 having a tip 49, 50. Popov does not address the materials used to form the tubular body or the tip. Applicant has not disclosed that having at least one of the tubular body and tip formed from an optically clear material solves any stated problem or is for any particular purpose. Moreover, it appears that the tubular body and tip of Popov, or applicant's invention, would perform equally well with the tubular body and tip being formed from any material.

Accordingly, it would have been prima facie obvious to a person having ordinary skill in the art at the time the invention was made to have modified Popov such that at least one of the tubular body and tip is formed from an optically clear material because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Popov.

### ***Allowable Subject Matter***

12. Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 9:00am-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deanna K. Hall/

Examiner, Art Unit 3767

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767